

REMARKS

Claims 1 through 8 are pending in this Application. Claims 1 and 3 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, page 13 of the written description of the specification, lines 11 through 21. Applicants note that the amendment to claim 3 merely addresses formalistic issue. Applicants submit that the present Amendment does not generate any new matter issue.

Initialed copy of Form PTO-1449.

Applicants acknowledge, with appreciation, the Examiner's inclusion of initialed copies of Forms PTO-1449 indicating the consideration of the cited prior art. However, Applicants note that the initialed copy of Form PTO-1449, which was submitted with an information disclosure statement (IDS) on June 1, 2001, is initialed in one box for two references, i.e., the Ishakawa et al. reference and the Kent et al. While Applicants assume that both of these references were considered by the Examiner, Applicants request the Examiner to clarify the record by providing a copy of Form PTO-1449 with initials opposite each of the references cited.

Claims 1 through 6 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Ishakawa et al.

In the statement of the rejection the Examiner referred to Figs. 29-35 and sections of the patent text, asserting the disclosure of an optical transmission system corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically

claimed invention is placed into the recognized possession of one having ordinary skill in the art.

Dayco Prods., Inc. v. Total Containment, Inc. 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

There is a fundamental difference between the claimed optical transmission system and that disclosed by Ishakawa et al. that scotches the factual determination that Ishakawa et al. disclose an optical transmission system identically corresponding to that claimed.

Specifically, in accordance with amended claim 1, the optical transmission system comprises an optical fiber transmission line which is composed of a single-mode optical fiber or a non-zero dispersion-shifted optical fiber. On the other hand, the optical transmission system disclosed by Ishakawa et al. does not contain such an optical fiber transmission line. Rather, it should be apparent that Ishakawa et al. employ a DSF (Dispersion-Shifted Fiber) as the optical fiber transmission line.

The above argued structural difference between the claimed optical transmission system and that disclosed by Ishakawa et al. undermines the factual determination that Ishakawa et al. disclose an optical transmission line identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 6 under 35 U.S.C. §102 for lack of novelty as evidenced by Ishakawa et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claim 7 was rejected under 35 U.S.C. §103 for obviousness predicated upon Ishakawa et al. in view of Danziger et al.

Claim 8 was rejected under 35 U.S.C. §103 for obviousness predicated upon Ishakawa et al. in view of Eggleton et al.

Each of the above rejections under 35 U.S.C. §103 is traversed. Specifically, each of claims 7 and 8 depend ultimately from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §102 for lack of novelty as evidenced by Ishakawa et al. The secondary references to Danziger et al. and Eggleton et al. do not cure the argued deficiencies in Ishakawa et al. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants do **not** agree that the requisite fact-based motivation has been established, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claim 7 under 35 U.S.C. §103 for obviousness predicated upon Ishakawa et al. in view of Danziger et al., and the imposed rejection of claim 8 under 35 U.S.C. §103 for obviousness predicated upon Ishakawa et al. in view of Eggleton et al., are not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited. Applicants again solicit the Examiner to

provide a completely initialed copy of Form PTO-1449 indicating consideration of each of the references cited in the IDS submitted June 1, 2001.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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